

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MARYLAND**

**AMERICAN INSTITUTE OF PHYSICS,
INC.,**
One Physics Ellipse
College Park, MD 20740

Plaintiff,

Case No. 8:13-cv-03453

v.

**BRITISH BROADCASTING
CORPORATION,**
Second Floor, Broadcast Centre
201 Wood Lane, London W12 7TP
UK,

Defendant.

COMPLAINT

Plaintiff American Institute of Physics, Inc. (“AIP” or “Plaintiff”) brings this Complaint against Defendant, British Broadcasting Corporation (“Defendant”), and alleges as follows:

PARTIES

1. AIP is a New York not-for-profit membership corporation located in College Park, Maryland. Founded in 1931, AIP promotes the advancement and diffusion of scientific knowledge to the public. AIP represents scientists, engineers and educators throughout the United States and the world and is among the world’s largest publishers of scientific information. This case concerns AIP’s federally registered and incontestable trademark INSIDE SCIENCE.

2. Defendant is a British corporation headquartered in London, United Kingdom. Defendant also has offices in New York, Los Angeles and Miami. Defendant is a broadcaster that provides educational and entertainment services throughout the world, including in the

United States and Maryland. Defendant is using AIP's trademark INSIDE SCIENCE to offer services that are very similar to those offered by AIP under the mark.

JURISDICTION AND VENUE

3. AIP asserts claims under the federal Lanham Act, 15 U.S.C. § 1051 *et seq.* and Maryland law for trademark infringement, unfair competition, false designation of origin and unfair business practices.

4. The Court has subject matter jurisdiction over the federal claims under 28 U.S.C. §§ 1331 and 1338, and over the state law claims under 28 U.S.C. § 1367.

5. The Court has personal jurisdiction over Defendant because Defendant provides educational and entertainment services under the infringing mark in the United States and Maryland and has caused Plaintiff harm in Maryland.

6. Venue is proper under 28 U.S.C. § 1391 because a major part of the events giving rise to Plaintiff's claims occurred in this District.

AIP AND ITS INSIDE SCIENCE MARKS

7. AIP promotes the advancement and diffusion of the knowledge of physics and its application to human welfare. AIP serves its member societies, individual scientists, students and the general public.

8. Since 1994, AIP has been using the mark INSIDE SCIENCE for educational and entertainment goods and services directed to the general public.

9. For over ten years, AIP has owned the domain name **insidescience.org**. AIP's **insidescience.org** web site features news articles, videos, columns, blog entries and other content all under the INSIDE SCIENCE mark. AIP's site has received more than 4.4 million page views

since January 2012 – more than one-third of these views are from visitors located outside of the United States, and over 195,000 of these views are from the United Kingdom.

10. Plaintiff's INSIDE SCIENCE news service publishes articles on a comprehensive range of topics. Plaintiff's INSIDE SCIENCE articles have been carried by large, mainstream news organizations such as Fox and NBC, as well as other organizations, including in the UK.

11. AIP produces a television program called INSIDE SCIENCE, which is syndicated to 39 television stations throughout the United States, and is distributed to broadcast networks internationally including those providing INSIDE SCIENCE content to EU member states.

12. AIP provides an email alert service under the mark INSIDE SCIENCE, which has subscribers throughout much of the world. AIP also maintains a Facebook account under the name INSIDE SCIENCE, which has received thousands of "likes," including from fans located outside of the United States.

13. AIP produces INSIDE SCIENCE-branded video cassettes featuring news stories in the field of science.

14. AIP owns a federal trademark registration for INSIDE SCIENCE, Reg. No. 2,099,051, for video tapes featuring news stories in the field of science. AIP owns pending Application No. 86/098,834 in the United States Patent and Trademark Office for INSIDE SCIENCE for educational and entertainment services in the fields of science, engineering and mathematics. AIP also owns a pending application in the European Community Trademark Office for INSIDE SCIENCE for educational and entertainment services.

15. The United States Patent and Trademark Office registered AIP mark INSIDE SCIENCE mark without proof of secondary meaning. AIP's mark INSIDE SCIENCE is an inherently distinctive mark for AIP's goods and services.

16. AIP's federal registration for INSIDE SCIENCE is "conclusive evidence" of the validity of that mark, of AIP's ownership of that mark and of AIP's "exclusive right to use" that mark in commerce for video tapes featuring news stories in the field of science. 15 U.S.C. § 1115.

17. AIP owns common law (unregistered) rights in the mark INSIDE SCIENCE for entertainment and educational goods and services.

18. Consumers associate the mark INSIDE SCIENCE exclusively with goods and services offered by AIP.

DEFENDANT AND ITS INFRINGING ACTS

19. Defendant offers entertainment and educational services in the United States and Maryland through broadcasting content on radio, TV and online.

20. In July 2013, Defendant premiered a radio program titled INSIDE SCIENCE. On Defendant's program, Defendant features various scientific discoveries, phenomena, and other topics in the field of science.

21. Defendant's INSIDE SCIENCE program reaches the general public, including the general public in the United States and Maryland.

22. Defendant has directed its INSIDE SCIENCE program to be accessible to customers in the United States and Maryland. Defendant's INSIDE SCIENCE program is available to customers in the United States and Maryland, including through the United States iTunes store and Defendant's web site.

23. Defendant's web site **bbc.com** features information on Defendant's INSIDE SCIENCE program, including podcasts and blog entries, which are accessible to consumers in the United States and in Maryland and which, on information and belief, are accessed by

substantial numbers of people located in the United States and Maryland. Defendant's web site allows consumers to download Defendant's INSIDE SCIENCE program.

24. The parties are using identical or substantially identical marks for substantially similar goods and services.

25. The parties target the same customers with their INSIDE SCIENCE marks and advertise and promote their INSIDE SCIENCE marks in the same channels of trade.

26. In July 2013, AIP demanded that Defendant cease use of INSIDE SCIENCE. Defendant refused to comply.

27. The parties engaged in settlement negotiations over several months, but Defendant refused to stop using INSIDE SCIENCE.

28. Defendant's use of the mark INSIDE SCIENCE causes a likelihood of confusion and mistake with AIP's mark INSIDE SCIENCE.

29. Defendant's infringement of AIP's mark is willful. Defendant is profiting from AIP's goodwill in the INSIDE SCIENCE mark.

30. AIP has lost control over the nature and the quality of the goods and services that are being offered under AIP's mark INSIDE SCIENCE.

COUNT I

TRADEMARK INFRINGEMENT, UNFAIR COMPETITION AND FALSE DESIGNATION OF ORIGIN UNDER THE LANHAM ACT (15 U.S.C. § 1114)

31. AIP incorporates Paragraphs 1-30 above as if alleged herein.

32. AIP owns a federally registered mark for INSIDE SCIENCE for "video tapes featuring news stories in the field of science."

33. Defendant's use of AIP's mark INSIDE SCIENCE constitutes trademark infringement, unfair competition and false designation of origin, in violation of the federal Lanham Act, 15 U.S.C. § 1114, because such conduct is likely to cause confusion, mistake or deception as to the source, origin, approval, sponsorship, affiliation, connection or association of Defendant's services and commercial activities.

34. Defendant's use of INSIDE SCIENCE and all similar marks is irreparably injuring AIP.

COUNT II

TRADEMARK INFRINGEMENT, UNFAIR COMPETITION AND FALSE DESIGNATION OF ORIGIN UNDER THE LANHAM ACT (15 U.S.C. § 1125)

35. AIP incorporates Paragraphs 1-30 above as if alleged herein.

36. AIP owns common law marks for INSIDE SCIENCE for educational and entertainment services and related goods and services.

37. Defendant's use of AIP's mark INSIDE SCIENCE constitutes trademark infringement, unfair competition and false designation of origin in violation of the federal Lanham Act, 15 U.S.C. § 1125, because such conduct is likely to cause confusion, mistake or deception as to the source, origin, affiliation, approval, sponsorship, connection or association of Defendant's services and commercial activities.

38. Defendant's use of INSIDE SCIENCE and all similar marks is irreparably injuring AIP.

COUNT III

**TRADEMARK INFRINGEMENT, UNFAIR COMPETITION AND FALSE
DESIGNATION OF ORIGIN UNDER MARYLAND LAW
(Maryland Common Law)**

39. AIP incorporates Paragraph 1-30 above as if alleged herein.

40. AIP owns valid marks for INSIDE SCIENCE for educational and entertainment services and related goods and services.

41. Defendant's use of AIP's mark INSIDE SCIENCE constitutes trademark infringement, unfair competition and false designation of origin, in violation of Maryland common law, because such conduct is likely to cause confusion, mistake or deception as to the source, origin, affiliation, connection or association of Defendant's services and commercial activities.

42. Defendant's use of INSIDE SCIENCE and all similar marks is irreparably injuring AIP.

COUNT IV

**VIOLATION OF MARYLAND UNFAIR OR DECEPTIVE TRADE PRACTICES ACT
(Md. Code, Com. Law §§ 13-301 *et seq.*)**

43. AIP incorporates Paragraph 1-30 above as if alleged herein.

44. Defendant's use of AIP's mark INSIDE SCIENCE constitutes a false and misleading representation that Defendant's services and commercial activities are sponsored or approved by or affiliated or connected with AIP in violation of Md. Code, Com. Law. § 13-301(2)(ii).

45. Defendant's wrongful conduct is intentional and has deprived AIP of its right to control the nature and quality of the goods and services being offered under its mark INSIDE SCIENCE.

JURY DEMAND

AIP requests a trial by jury on all issues so triable.

PRAYER FOR RELIEF

AIP requests that the Court grant the following relief:

- A. A preliminary, permanent injunction and worldwide injunction enjoining Defendant, its controlling principals, employees, owners, agents, officers, directors, attorneys, representatives, affiliates, subsidiaries, and successors and assigns, and all those in active concert or having knowledge of the causes of action, from using INSIDE SCIENCE, by itself or in combination with other acronyms, terms, words and/or designs;
- B. An award of AIP's actual damages, and Defendant's profits and/or unjust enrichment, to be proven at trial;
- C. An award of AIP's reasonable costs and attorneys' fees incurred in connection with this action, pursuant to the 15 U.S.C. § 1117 and Md. Code, Com. Law, § 13-408(b); and
- D. Other further relief as the Court deems just and necessary.

Dated: November 15, 2013

Respectfully submitted,

/s/ John J. Dabney

John J. Dabney (Bar No. 17795)

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